REMARKS

Claims 9, 10, 28, 29, 47 and 48 are canceled herein. Claims 1-8, 11, 12, 20-27, 30,31, 39-46 and 49-56 now remain pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

Claims 1-5, 11, 12, 20-31, 39-45, 47, 49 and 50 over Burgan in view of Bunney and WebTV

In the Office Action, claims 1-5, 11, 12, 20-31, 39-45, 47, 49 and 50 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Burgan et al., U.S. Patent No. 6,459,892 ("Burgan") in view of U.S. Patent No. 6,446,112 to Bunney et al. ("Bunney"), and further in view of *WebTV to IRC Proxy debuts on SorceryNet*, USENET posting in atl.online-service.webtv 10/18/1999 ("WebTV"). The Applicants respectfully traverse the rejection.

Claims 28, 29 and 47 are canceled herein, making the rejection of claims 28, 29 and 47 now moot.

Claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 recite a system and method relying on a <u>wireless</u> mobile device that sends a message to a standard IRC server.

Only <u>one</u> of the <u>three</u> cited references, Burgan, used to reject claims 1-5, 11, 12, 20-31, 39-45, 47, 49 and 50 has any applicability to unique problems associated with <u>wireless mobile devices</u>. An evaluation of obviousness must be undertaken from the perspective of one of ordinary skill in the art addressing the <u>same problems</u> addressed by the applicant in arriving at the claimed invention. <u>Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve</u>, 23 USPQ 416, 420 (Fed. Cir. 1986), <u>cert. denied</u>, 484 US 823 (1987). Thus, the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claimed invention. <u>In re Newell</u>, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). Nothing within Bunney nor WebTV

suggests applicability of any teachings to problems associated with <u>wireless mobile devices</u>, much less <u>wireless mobile devices</u> that participate with <u>IRC</u>.

Claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 recite a system and method relying on a <u>wireless Internet</u> gateway server.

As discussed above, only <u>one</u> of the <u>three</u> cited references, Burgan, used to reject claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 has any applicability to unique problems associated with <u>wireless mobile devices</u>. However, none of Burgan's mobile wireless devices have any access to the <u>Internet</u> (See Fig. 1), much less to a <u>wireless Internet</u> gateway server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

Claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 recite a system and method of sending a first message from a **<u>non-Internet Relay Chat program</u> <u>adapted to be executed by a</u> <u>wireless mobile device</u>** to a **<u>mobile</u> chat proxy server** and forwarding a second message compatible with an standard **<u>Internet Relay Chat server</u>** to the standard Internet Relay Chat server.

The Examiner has **<u>still</u>** failed to provide a single reference that discloses a <u>non-Internet Relay Chat program adapted to be executed by a</u> **<u>wireless mobile device</u>** that is used to communicate with an IRC server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

The Examiner acknowledges that Burgan fails to disclose a chat proxy server connected to a standard Internet Relay Chat server (See Office Action, page 5). The reason Burgan fails to disclose a chat proxy server connected to a standard Internet Relay Chat server is that Burgan fails to disclose **<u>either</u>** a chat proxy server **<u>or</u>** a standard Internet Relay Chat server. Since Burgan fails to require **<u>either</u>** a chat proxy server or a standard Internet Relay Chat server for the numerous devices throughout the system to chat with one another, any modification of Burgan is based on **<u>improper hindsight</u>**. Moreover, for Burgan to connect to a standard Internet Relay Chat server, Burgan would further have to be modified to be connected to the Internet. Thus, even if the cited prior art disclosed the claim elements individually (which as discussed herein, the cited prior art fails to do), "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the

teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Thus, nothing within the cited prior art provides a **suggestion** or **incentive** to modify Burgan to connect to the **Internet**, to connect to a chat proxy server **or** to connect to a standard Internet Relay Chat server, much less **all of** a connection to the **Internet**, a chat proxy server **and** a standard **Internet Relay Chat server**. "Teachings of references can be combined only if there is some **suggestion** or **incentive** to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

The Examiner acknowledges that Burgan fails to disclose a chat proxy server connected to a standard **Internet Relay Chat server** (See Office Action, page 5). The Examiner relies on Bunney and WebTV to allegedly make up for the deficiencies in Burgan to arrive at the claimed features. The Applicants respectfully disagree.

The Examiner alleges Bunney discloses mobile device to originate a chat session with a standard IRC server (See Office Action, page 5). However, as discussed above nothing within Bunney discloses or suggests any applicability to unique problems associated with **wireless mobile devices**, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

The Examiner acknowledges that Burgan fails to disclose a chat proxy server connected to a standard IRC server (See Office Action, page 5). However, the Examiner alleges the motivation of modifying Burgan with Bunney's chat proxy server connected to a standard IRC server is to enable mobile users to fully participate in IRC chat sessions with world wide users is nonsensical (See Office Action, page 5).

Bunney's chat proxy server is used to translate a non-compliant IRC address and rewriting an IRC command. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). All of Burgan's chat functions must occur within a wireless network. Burgan fails to

disclose or suggest connection of wireless devices to the Internet, much less disclose or suggest use of chat commands that are Internet Relay Chat compatible. Thus, modifying Burgan that lacks IRC compatible commands with Bunney's proxy server that is designed to receive IRC chat commands is **nonsensical** since the two systems are incompatible and would result in an inoperable system.

Moreover, as discussed above, Bunney fails to disclose or suggest any applicability to unique problems associated with mobile wireless devices, much less a mobile wireless device that uses a non-IRC program to communicate with a standard IRC server. The Examiner has still failed to provide a **single reference** that discloses a **non-Internet Relay Chat program adapted to be executed by a wireless mobile device**, much less used to communicate with a standard IRC server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

WebTV is relied on to disclose a chat proxy for permitting limited functionality client devices, i.e., WebTV devices, to participate fully in an IRC network by facilitating connection, translation and forwarding of commands from WebTV users to an IRC server (See Office Action, page 5).

As discussed above, WetbTV fails to disclose or suggest any applicability to unique problems associated with mobile wireless devices, much less a mobile wireless device that uses a non-IRC program to communicate with a standard IRC server. The Examiner has still failed to provide a **single reference** that discloses a non-Internet Relay Chat program adapted to be executed by **a mobile device**, much less used to communicate with a standard IRC server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

WebTV's proxy server is used to facilitate connection, translation and forwarding of commands from WebTV users to an IRC server. By the Examiner's own acknowledgement, WebTV **only** has application to servicing WebTV devices. Thus, modifying Burgan's system servicing mobile devices with WebTV's proxy server **only** servicing WebTV devices is **nonsensical** since providing **no functionality** to a wireless mobile device. WebTV fails to disclose

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or <u>suggest</u> application of any of disclosed features to anything other than a proxy server servicing <u>WebTV devices</u>.

Therefore, modifying Burgan with the disclosure of Bunney and WebTV is not only **nonsensical**, but fails to disclose or **suggest** a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by **a wireless mobile device** to a mobile chat proxy server and forwarding a second message compatible with an standard IRC server to the standard IRC server, as recited by claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50.

The Examiner argues that WebTV is not relied to be bodily incorporated into the structure of the Burgan, but rather what WebTV allegedly suggests to those of ordinary skill in the art (See Office Action, page 3). The Applicants respectfully disagree.

The Examiner acknowledges that WebTV teaches providing a proxy that translates commands from a limited comuting device (WebTV) to IRC commands so as to enable a user of the device to fully participate in IRC as that of a computer user (See Office Action, page 3). However, the Examiner has still fails to provide **where** WebTV suggests to those of ordinary skill in the art application to any system besides WebTV, much less to a <u>wireless mobile device</u>. As discussed above, the Examiner is using the Applicants' claims as a <u>template</u> to construct the Applicants' claims **without any suggestion within the cited prior art** for modification of the primary reference, Burgan, to rely on a **non-Internet Relay Chat program** adapted to be executed by **a wireless mobile device** or for application of the secondary references, Bunney and WebTV to a <u>wireless mobile device</u>, much less a <u>wireless mobile device</u> relying on a <u>non-Internet Relay Chat program</u>.

Claims 12, 31 and 50 recite a system and method of <u>ghosting</u> a channel of an Internet Relay Chat group through a <u>non-IRC program</u> associated with a mobile device.

Burgan fails to disclose or **suggest** <u>ghosting</u>, much less using <u>ghosting</u> with a <u>non-Internet Relay Chat program</u>, i.e., a system and method of

ghosting a channel of an Internet Relay Chat group through a short messaging service associated with a mobile device, as recited by claims 12, 31 and 50.

As discussed above, Bunney fails to disclose or **suggest** ghosting, much less using ghosting with a non-Internet Relay Chat program, i.e., a system and method of ghosting a channel of an Internet Relay Chat group through a short messaging service associated with a mobile device, as recited by claims 12, 31 and 50.

The Examiner argues that WebTV discloses a proxy that can handle MODE commands, with the system inherently having the capability to send a ghosting command (See Office Action, page 4). However, inherency is **not applicable** in a rejection under §103. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Moreover, under the doctrine of necessary inherency, anticipation may be established when a single prior art reference fails to disclose the claimed invention ipsissimis verbis, but the natural and invariable practice of the reference would necessarily inherently meet all the elements of the claim. See, e.g., Verdegaal Bros., Inc. v. Union Oil Col. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 245 (Fed. Cir. 1985); Ethyl Molded Products Co. v. Betts Package Inc., No. 85-111 1032 (D.C.E.D. Kent. 1988). The doctrine of inherency is available only when the inherency can be established as a certainty; probabilities are not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Chandler, 254 F.2d 396, 117 USPQ 361 (CCPA 1981); Ethyl Molded Prod. Co. at 1032. Just because a cited reference discloses a proxy that can handle MODE commands doesn't equate to a proxy that can handle **all** MODE commands. WebTV is directed to a system and method of allowing a WebTV device to participate with IRC. However, WebTV fails to disclose that **all** IRC functions as supported. The Examiner has failed to established as a **certainty** that WebTV can process a ghosting command.

Thus, Burgan modified by the disclosure of Bunney and WebTV would fail to disclose or **suggest** using ghosting with a non-Internet Relay Chat

program, i.e., a system and method of ghosting a channel of an Internet Relay Chat group through a short messaging service associated with a mobile device, as recited by claims 12, 31 and 50.

Accordingly, for at least all the above reasons, claims 1-5, 11, 12, 20-27, 31, 39-45, 49 and 50 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 6, 7, 9, 10 and 48 over Burgan in view of Bunney, WebTV and Ramasubramani

In the Office Action, claims 6, 7, 9, 10 and 48 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Burgan in view of Bunney and WebTV, and further in view of U.S. Patent No. 6,314,108 to Ramasubramani et al. ("Ramasubramani"). The Applicants respectfully traverse the rejection.

Claims 10 and 48 are canceled herein, making the rejection of claims 10 and 48 now moot.

As discussed above, Burgan in view of Bunney, and further in view of WebTV fails to disclose or suggest a system and method of sending a first message from a non-Internet Relay Chat program associated with a **wireless mobile device** to a **mobile** chat proxy server and forwarding a second message compatible with an standard **Internet** Relay Chat server to the standard Internet Relay Chat server, as recited by claims 6, 7 and 9.

The Examiner relies on Ramasubramani to allegedly make up for the deficiencies in Burgan in view of Bunney and WebTV to arrive at the claimed features. The Applicants respectfully disagree.

Ramasubramani discloses a proxy server the interconnects various wireless network carriers having different wireless network characteristics (See Abstract). However, Ramasubramani fails to disclose any of those wireless network carriers have IRC capability, much less rely on an IRC server. Ramasubramani fails to disclose or suggest a wireless Internet gateway server and a **single reference** that discloses a **non-Internet Relay Chat program** adapted to be executed by **a wireless mobile device** used to communicate with a standard IRC server, as recited by claims 6, 7 and 9.

Thus, the Examiner has still failed to provide a single prior art reference that discloses or suggests a **non-Internet Relay Chat program** **adapted to be executed by a wireless mobile device** used to communicate with a standard IRC server, much less a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile chat proxy server** and forwarding a second message compatible with an standard **Internet Relay Chat server** to the standard Internet Relay Chat server, as recited by claims 6, 7 and 9.

Thus, Burgan modified by the disclosure of Bunney, WebTV and Ramasubramani still fails to disclose or suggest a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile chat proxy server** and forwarding a second message compatible with an standard **Internet Relay Chat server** to the standard Internet Relay Chat server, as recited by claims 6, 7 and 9.

Accordingly, for at least all the above reasons, claims 6, 7 and 9 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 8, 46 and 51-56 over Burgan in view of Bunney, WebTV and Gudjonsson

In the Office Action, claims 8, 46 and 51-56 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Burgan in view of Bunney and WebTV, and further in view of U.S. Patent No. 6,564,261 to Gudjonsson et al. ("Gudjonsson"). The Applicants respectfully traverse the rejection.

As discussed above, Burgan in view of Bunney, and further in view of WebTV fails to disclose or suggest a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile chat proxy server** and forwarding a second message compatible with an standard **Internet Relay Chat server** to the standard Internet Relay Chat server, as recited by claims 8, 46 and 51-56.

The Examiner relies on Gudjonsson to allegedly make up for the deficiencies in Burgan in view of Bunney and WebTV to arrive at the claimed features. The Applicants respectfully disagree.

Gudjonsson is relied on to disclose usage of a short message service for a mobile user to chat with a PC user (See Office Action, page 8). However, Gudjonsson, like Burgan, Bunney and WebTV, fails to disclose or suggest a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** used to communicate with a standard IRC server, much less a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile** chat proxy server and forwarding a second message compatible with an standard **Internet** Relay Chat server to the standard Internet Relay Chat server, as recited by claims 8, 46 and 51-56.

Thus, the Examiner has still failed to provide a single prior art reference that discloses or suggests a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** used to communicate with a standard IRC server, much less a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile** chat proxy server and forwarding a second message compatible with an standard **Internet** Relay Chat server to the standard Internet Relay Chat server, as recited by claims 8, 46 and 51-56.

Thus, Burgan modified by the disclosure of Bunney, WebTV and Gudjonsson fails to disclose or suggest a system and method of sending a first message from a **non-Internet Relay Chat program** adapted to be executed by a **wireless mobile device** to a **mobile** chat proxy server and forwarding a second message compatible with an standard **Internet** Relay Chat server to the standard Internet Relay Chat server, as recited by claims 8, 46 and 51-56.

Moreover, The Examiner alleges that it is inherent that a system as allegedly modified would have short message service capability (See Office Action, page 8). However, as discussed above inherency is **not applicable** in a rejection under §103. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Accordingly, for at least all the above reasons, claims 8, 46 and 51-56 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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